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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,633	06/13/2001	Bassem M. Demian	176746-3	7621

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EXAMINER

DAHBOUR, FADI H

ART UNIT PAPER NUMBER

3743

DATE MAILED: 12/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,633

Applicant(s)

DEMIAN, BASSEM M.

Examiner

Fadi H. Dahbour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9, 10 and 12 is/are rejected.
- 7) ☒ Claim(s) 4-8, 11 and 13-21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Diamantopoulos et al.

Diamantopoulos discloses a method of correcting a bunion condition in a foot comprising applying an electrical signal to the abductor digiti minimi brevis muscle to strengthen the abductor digiti minimi brevis muscle and counter balance the strength of the flexor digitorum muscle to correct for an imbalance between the two muscles (Figure 9, also see “biostimulation of tissue” in line 1 of abstract, also see “patient was found to have a...chronic bunion...treated with a multi-diode biostimulation device of the present invention...660 nm, 820 nm, 880 nm, 950 nm” in lines 24–28 of column 10).

3. Claims 1-3, 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kenney.

Kenney discloses a bunion correction device comprising means for attaching at least one electrode to the foot for applying an electrical signal to the abductor digiti minimi brevis muscle in the foot for strengthening the abductor digiti minimi brevis muscle to counter balance the strength of the foot flexor digitorum muscle to correct a bunion in the small toe (Figure 20, also see "strategically placed electrodes placed on the body to provide electrical current to the desired site" in lines 30-31 of column 4, also see "electrodes strategically placed relative to the orthotic device, for example, in or on the orthotic device, to combine orthotic treatment and electrotherapy" in lines 45-47 of column 7), and signal generator means for generating the electrical signal and applying the generated signal to the at least one electrode (see "a power source, for example, an electrotherapy unit...is used to provide electrical power or energy to the electrode component so that electrical current can be provided to the desired body part or parts" in lines 47-52 of col. 7, also see 705 of Figure 27, also see "electrical signal transmitter to receptor electrode connections" in lines 42-43 of column 23), wherein the means for attaching comprises strap means for encircling the foot (Figure 20) and means for securing the at least one electrode to the strap means (see 701 of Figure 27) for abutting the foot when the strap means is attached to the foot (Figure 20), wherein the strap means comprises a strap for encircling the foot (Figure 20), including two spaced electrodes arranged on the strap means (see 701 of Figure 27) for overlying the abductor digiti minimi brevis muscle of the foot in two spaced locations (Figure 20), wherein the generating means includes means for applying a generated signal (see 705 of Figure 27, also see "a power source, for example, an electrotherapy unit...is used to

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provide electrical power or energy to the electrode component so that electrical current can be provided to the desired body part or parts" in lines 47-52 of column 7, also see "electrical signal transmitter to receptor electrode connections" in lines 42-43 of col.23) to two electrodes (701 of Figure 27).

Allowable Subject Matter

4. Claims 4-8, 11, 13-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sakano, Mir et al, Hattori et al, Kallok, Friedman et al and Burghelle et al are cited to show electrode devices and methods.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadi H. Dahbour whose telephone number is 703-306-5479. The examiner can normally be reached on M-F, 9am-5:30pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett, can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.



Fadi H. Dahbour
Examiner
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